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RESPONSE under 37 C.F.R. § 1.111
U.S. Appln. No. 10/026,397**REMARKS:**

Claims 20-38 are all the claims pending in the present application. Claim 31 is objected to and claims 20-30 and 32-38 stand rejected. Reconsideration and allowance of all claims are respectfully requested in view of the remarks that follow.

PRIOR RESPONSE.

The Office Action indicates that Applicant's prior response and, although persuasive, the claims remain rejected because "dynamically generating classmark information is obvious" and the language relating to "client applications/operating systems running on the mobile device... is not clearly incorporated in any claims.."

In response, Applicant respectfully submits that (i) since no reference or combination of references discloses or suggests "dynamically generating a client classmark" *prima facie* obviousness not established and (ii) the claim term "client classmark" incorporates the interpretation to client devices as well as the express language in the claims that the client classmark is used by one or more applications executing on the mobile device.

CLAIM OBJECTIONS.

Claim 21 is objected to under 37 C.F.R. § 1.75(c) as failing to further define the subject matter of the claim from which it depends (claim 20). Applicant respectfully submits that "*the mobile computing device is further adapted to communicate using a first and second communication service*" further defines the invention recited in claim 20 and thus complies with all requirements of 37 C.F.R. § 1.75. Reconsideration is respectfully requested.

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CLAIM REJECTIONS.

35 U.S.C. § 112 (First Paragraph)

Claim 21 is rejected under 35 U.S.C. § 112, first paragraph as being non-enabling. The Office Action apparently alleges it is unclear how a "device is further adapted to communicate using a first and second communication service" Applicant respectfully traverses this rejection. By way of example, a first communication service could be a wired link and a second communication service might be a wireless link. (Spec. pg. 7, ll. 7-12). Alternatively, a first communication service could be a CDMA service and a second communication service could be a wireless local area network (WLAN) service. (Spec. pg. 7, ll. 13-22 and pg. 8, ll. 1-3). Reconsideration and withdrawal of this rejection are respectfully requested.

35 U.S.C. § 112 (Second Paragraph)

Claims 26 and 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action alleges that the terms "physical capabilities" and "logical capabilities" would not be understood by the skilled artisan. Applicant respectfully disagrees and reiterates the citations to the specification previously of record. (Pg. 12, ll. 2-7; pg. 12, ll. 13-20). Applicant further reminds the Examiner that claims are not to be read in a vacuum but should be given the interpretation consistent with that of one of ordinary skill in the art when read light of the specification and the teachings of the prior art. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999).

Respectfully, Applicant submits that there can be only so many "physical cababilities" (e.g., memory, cache, processing capabilities, input/output devices, etc.) or "logical capabilities" (e.g., virtual machine capabilities, synchronization, translators, mail services, etc.) of the mobile device pertinent to a client classmark. Because the skilled artisan, would realize, in light of Applicant's specification the scope of Applicant's claimed invention, the claims are

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believed to be definite. If the claims, read in light of the specification, reasonably comprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, 35 U.S.C. § 112 second paragraph demands no more. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985).

In any event, because the Office Action has not met the burden of showing why the skilled artisan would not understand the scope of Applicant's claims, when read in light of Applicant's specification, a *prima facie* rejection under 35 U.S.C. § 112 has not been established and the rejection should be withdrawn. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of this rejection.

35 U.S.C. § 102

Claim 25 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 6,002,939 to Roel-Ng et al. (hereinafter "Roel-Ng"). Applicant respectfully traverses this rejection for the following reasons.

It is well established that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1997).

In this case at hand, and as explained previously in the record, Roel-Ng fails to disclose or suggest a client classmark (to be used by one or more client applications executed in the mobile device as recited in Applicant's claim 25). Instead Roel-Ng discloses sending a classmark information message 310, which includes information about the mobile station to the mobile switching center (MSC) 350 or base station controller (BSC) 340. If the Examiner continues to disagree with Applicant, it is requested that the Office Action cite with some specificity what element in Roel-Ng is considered to be a client classmark....to be used by one or more client applications executed in the mobile device.

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In the absence of this showing, and in fact because Roel-Ng fails to teach or suggest any client classmark whatsoever, it cannot anticipate Applicant's claim 25. In view thereof, reconsideration and withdrawal of this rejection are respectfully requested.

35 U.S.C. § 103(a)

1.) Claims 20-24 and 26-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roel-Ng in view of various secondary references/combinations including US 6,405,241 to Gosling et al. (hereinafter "Gosling"), US 5,410,651 to Sekizawa et al. (hereinafter "Sekizawa"), U.S. 6,480,966 to Rawson III, and/or European Patent Application EP 0980190 to Koehne et al. (hereinafter "Koehne"). Applicant respectfully traverses these rejections for the reasons that follow.

It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In all the foregoing 103 rejections, the Office Action relies solely on Roel-Ng to disclose *dynamically generating the client classmark as the mobile computing device is moved* (e.g., Applicant's claim 20). As discussed above with respect to §102 rejection based on Roel-NG, this reference fails to teach or suggest generation a client classmark to be used by one or more client applications executing in the mobile computing device to identify one or more current attributes of the mobile computing device, as recited in Applicant's claim 20 and similar limitations in Applicant's other claims. In fact, Roel-Ng and Gosling disclose the opposite of

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Applicant's claimed invention, by disclosing classmark information used by the MSC or BSC or a server (as opposed to the client) to determine the capabilities of a device.

Moreover, the secondary references cited in these rejections also fail to teach or suggest a client classmark to be used by one or more client applications executing in the mobile computing device to identify one or more current attributes of the mobile computing device. Accordingly, and without acquiescing or even addressing the properness of the motivation to combine the cited references, because Roel-Ng, Gosling, Sekizawa, Rawson III, and Koehne, alone or in any combination, fail to teach or suggest at least the foregoing features of Applicant's claims, *prima facie* obviousness has not been established and therefore the 103 rejections based on these references are unfounded. In view of the foregoing reconsideration and withdrawal of these rejections are respectfully requested.

2.) Claims 33-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koehne in view of US 6,973,518 to Purpura and/or in further view of Rawson III. Applicant respectfully traverses these rejections for the following reasons.

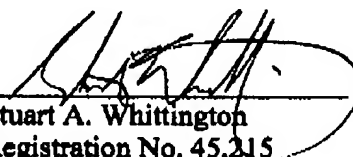
Koehne discloses a telecommunication device which stores information about supported modes, bands and/or subscriber specific networks which is compared with information received about currently available networks. Applicant respectfully believes that this disclosure by Koehne is not analogous to *dynamically generating a client classmark for the article based upon what communication services are available, wherein the client classmark is configured to be used by one or more client applications on a mobile device to determine capabilities of the mobile device* as recited in Applicant's claims. Further, since neither Purpura nor Rawson III teach or suggest the foregoing features of Applicant's claims, regardless of whether it would be proper to combine these references as proposed in the Office Action, *prima facie* obviousness has not been established and thus Applicant respectfully requests reconsideration and withdrawal of the §103 rejections based on these references.

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CONCLUSION.

In view of the above, reconsideration and allowance of this application is now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,


Stuart A. Whittington
Registration No. 45,215
Intel Corporation
(480) 715-3895

c/o
Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA. 90025-1026
(503) 264-0967

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